

REMARKS/ARGUMENTS

Claim 52 has been revised to remove extraneous language. No new matter has been introduced, and entry of the above revised claims is respectfully requested.

Applicants again point out that method claims 1-23, 83-89, 112-121, and 143-150 depend from the pending composition claims, and so the method claims are subject to rejoinder practice as set forth at MPEP 821.04 when the composition claims are found allowable. Acknowledgement of the applicability of rejoinder is respectfully requested.

Restriction Requirement

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks. As an initial matter, Applicants point out that pending claims 43, 71-76, 90-101, 110, and 111 are not included in any alleged group or as one of the alleged "linking" claims. Based upon Applicants belief that the Requirement reflects an improper attempt to restrict within claims directed to a genus, Applicants respectfully submit that these claims may not be properly restricted from the other pending claims.

Additionally, Applicants point out that the pending claims are directed to compositions and methods of using them. With respect to the compositions, they are combinations of materials where there is a specific relationship between the components of the composition. See for example, claims 31 and 69.

The Restriction Requirement alleges the following Groups:

- Group I, claims 52-59;
- Group II, claims 52-59;
- Group III, claims 52-59;
- Group IV, claims 52-59;
- Group V, claims 52-59, 60-62, and 104-107;
- Group VI, claims 52-59, 102 or 103;

Group VII, claims 44-46, 98 and 99;
Group VIII, claims 47-49, 108 and 109;
Group IX, claim 50;
Group X, claim 51; and
Groups XI-XVI, claims 9-22, 86-89, 112-121, and 143-150.

The Requirement alleges that each of Groups I-X (claims 44-62, 98, 99, and 102-109) is an invention relating to a composition comprising a ligand that is a "separate and distinct product". Additionally, the Requirement asserts that claims 31-42, 63-70, and 77-82 "link" Groups I-X while claims 1-8, 23, and 83-85 "link" Groups XI-XVI.

The Restriction Requirement further states that "[t]he restriction requirement between the linked inventions is subject to the nonallowance of the linking claims.... Upon the indication of allowability of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise requiring all the limitations of the allowable linking claims will be entitled to examination in the instant application." See paragraph bridging pages 4-5 of the Restriction Requirement.

Applicants understand the above to indicate that should one of Groups I-X or one of Groups XI-XVI be elected, the respective linking claims will be examined with the elected Group and should the linking claim be found allowable, the claims of the remaining linked Groups will be rejoined and fully examined for patentability.

Should this understanding be incorrect, Applicants request clarification in the next Office Communication of how the linking claims will be treated with the election of one of asserted Groups I-XVI.

Presence of Genus Claims

Even if the above understanding is correct, Applicants respectfully traverse the assertion of Groups I-X, and Groups XI-XVI, as two clusters of separate inventions that are "linked inventions." Applicants point out that the alleged separation of the claims into each of the two clusters appears to reflect a failure to recognize the presence of genus claims, as reflected

in claims 31 and 69 as representative examples. The asserted separation of claims into the Groups within each cluster is an improper separation of the genus into the species alleged as Groups I-X or XI-XVI *without recognition of the genus claims*.

A generic, or genus, claim is defined at MPEP 806.04(d). At least claims 31-45, 47, 48, 50, 51, 63-65, 69-82, and 90-99 are generic, or genus, claims within that definition. No reason has been provided as to why these claims are not generic, or genus, claims within the definition set forth at MPEP 806.04(d). In sharp distinction, claims 69-72 and 77-82 are identified as “generic” claims on page 9 of the Requirement. Most of these claims are alleged to be “linking” claims as noted above.

Applicants respectfully submit that it is improper, as well as legally inconsistent, to simultaneously allege claims as “linking”, and thus not generic, in one part of the Restriction Requirement, and as “generic” in another part of the Restriction Requirement.

Recognition of the presence of genus claims is important because Applicants regard the subject matter of the genus claims as their invention. Any attempt to restrict the genus to be merely species thereof would deny Applicants the ability to seek claims directed to what they regard as the invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02. These decisions clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a genus claim. Therefore, and by way of example, claims 31-45, 47, 48, 50, 51, 63-65, 69-82, and 90-99 cannot be divided by restriction.

The fact that restriction contrary to *Weber* and *Haas* has occurred is seen in the case of claims 43, 71-76, 90-101, 110, and 111 as examples. The instant restriction requirement clearly and improperly withhold these claims from examination and consideration because there is no inclusion of this subject matter in any of alleged Groups I-X.

In light of the above arguments, and even if the understanding of the prosecution of “linked inventions” indicated above is correct, Applicants respectfully request reconsideration

and modification of the instant Restriction Requirement at least in favor of one group in place of asserted Groups I-X and a second group in place of asserted Groups XI-XVI.

In the event that the Restriction Requirement is maintained, Applicant elects alleged Group II, claims 52-59 where the ligand binds a lipoprotein, with traverse for the reasons provided above.

Required election of species

The Restriction Requirement mailed September 13, 2006 further includes a requirement for election of a species from among 15 alleged "species of antigen" in the case of Groups I-X, and among 11 alleged "species of ligand" in the case of Groups XI-XVI.

As explained above, the requirement for an election of species includes a recognition of generic claims. Given the presence of genus claims, as presented above, Applicants point out that a requirement for an election of species from the genus of claimed compositions must be based upon 37 C.F.R. § 1.141(a) and 1.146, both of which expressly recognize that "a reasonable number" of species may be claimed along with an allowable generic claim within a single application. Applicant points out that there has been no demonstration that "more than a reasonable number of species" is encompassed by the pending claims. To the contrary, Applicants respectfully submit that the presence of 15 species is clearly "reasonable" in comparison to genus claims in issued patents that encompass enormous numbers of species. Therefore the requirement is deficient because no more than a reasonable number of species is presented in the pending claims.

Moreover, and as set forth at 37 C.F.R. § 1.146, election of a species is discretionary and results in a restriction *only* "if no claim to the genus is found to be allowable." Thus Applicants respectfully submit that the requirement for an election of species is for purposes of facilitating search and examination. If no prior art is found to anticipate or render obvious the elected species, Applicants respectfully submit that the search of the claims should be extended to the next species to allow for consideration of the generic claim encompassing the species.


In light of the above, Applicant respectfully submit that the requirement for an election of species is misplaced and should be withdrawn.

Should the requirement be maintained despite the above, Applicants elect the species of "a) viral organism" as encompassed by claims 69-74, 77-82, 90-101, and 108-111, where at least claims 69-74, 77-82, 90-101, 104-106, and 108-111 are generic. This election is made with traverse for the reasons provided above.

Applicants reserve the right to pursue the subject matter of any non-elected claim or canceled subject matter in a subsequent divisional or other continuing application without prejudice.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,


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